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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,908	12/15/2000	Jason Hill	CUB-5	2440

34103 7590 05/27/2005

CUBIST PHARMACEUTICALS, INC.
65 HAYDEN AVENUE
LEXINGTON, MA 02421

EXAMINER

LUKTON, DAVID

ART UNIT PAPER NUMBER

1653

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/737,908	Applicant(s) HILL ET AL.	
	Examiner David Lukton	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/14/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-31 is/are pending in the application.
 4a) Of the above claim(s) 13-16 and 18-31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 3,5,6 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 7-9 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Pursuant to the directives of the response filed 3/14/05, claims 3, 5, 21, 23-26 have been amended. Claims 3-31 remain pending. In view of the terminal disclaimers, the rejection of claims 3 and 4 as unpatentable over claim 1 of USP '490 is withdrawn as is the rejection of claims 3 and 4 as unpatentable over claim 1 as unpatentable over claim 1 of copending application Serial No. 09/738742.

Also withdrawn is the rejection of claims 3-12 and 17 under 35 U.S.C. 112, first paragraph. Claims 3-12 and 17 are examined in this Office action; claims 13-16 and 18-31 remain withdrawn from consideration. Claim 4 is characterized as allowable; claims 3, 5, 6, 10-12 remain rejected, and claims 7-9 and 17 are objected to because of their dependence on rejected claims.



The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 5, 6, 10-12 are rejected under 35 U.S.C. §102(b) as being anticipated by Abbot

(USP 4,537,717).

As indicated previously, Abbot discloses compound 23 in table III. This compound is encompassed by claim 3 when the substituent variables are as follows:

$R = N(B)(X)_m-A$, wherein

B = hydrogen

X = -CO-

A = alkyl

$R^1 = -N(B')(X')_m-A'$, wherein

B' = hydrogen

m = 1

X' = CO

A' = C12-alkyl

$R^2 = -CH_2-CO-$ aminophenyl

Applicants have argued that the amendment to claim 3 overcomes this rejection, because the claim now excludes the possibility that A' can be C₁₋₁₈ unsubstituted alkyl. According to one interpretation of the claim, this assertion is correct, but according to another interpretation of the claim, applicants' assertion is not correct. Claim 3 states that A' can be substituted alkyl, in which one of the substituents can be "an amino acid side chain". As applicants are aware, the side chain of alanine is methyl. Thus, the rejection can be maintained. In the event that applicants were to exclude the side chain of alanine, the rejection could still be maintained, since the claim does not limit the (side chain of the)

amino acid to be one that is genetically encoded. Thus, for example, A' could be ethyl that is substituted with the side chain of *alpha*-decyl glycine.

The rejection is maintained.




It is suggested (but not yet required) that applicants explain how to synthesize a compound according to claim 4 by the method of claim 31 when R¹⁶ (of claim 29) is -CH₂-piperidinyl.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.


DAVID LUKTON
PATENT EXAMINER
GROUP 1800